

**REMARKS**

Favorable reconsideration and allowance of the present application are respectfully requested in view of the following remarks. Claims 1-22 remain pending.

**ALLOWABLE SUBJECT MATTER**

Applicant appreciates that claims 2, 4-13, 15, 17, and 19-22 are indicated to be allowable.

**§ 102 REJECTION – HIRABAYASHI**

Claims 1, 3, 14, 16, and 18 stand rejected under 35 USC 102(b) as allegedly being anticipated by Hirabayashi et al. (USP 5,680,225) hereinafter “Hirabayashi”. Applicant respectfully traverses.

For a Section 102 rejection to be proper, the cited reference must teach or suggest each and every claimed element. *See M.P.E.P. 2131; M.P.E.P. 706.02.* Thus, if the cited reference fails to teach or suggest one or more elements, then the rejection is improper and must be withdrawn.

In this instance, Hirabayashi fails to teach or suggest each and every claimed element. For example, independent claim 1 recites, in part, “without previously enlarging which controls said original image data to said

predetermined number of pixels.” Independent claims 14 and 18 also recite similar features.

In the Final Office Action, the Examiner alleged that the recited feature “is a negative limitation.” *See Final Office Action, page 2, lines 5-7.* The Examiner went on to state that “the reference still read on every positive step recited in the claim.” *Emphasis added; see Final Office Action, page 2, line 17.* In other words, the Examiner simply ignored the recited feature. This is clearly improper.

MPEP clearly indicates that there is nothing inherently ambiguous or uncertain about negative limitations. So long as the boundaries of the patent protection sought are set forth definitely, albeit negatively, the claim complies with the requirements of 35 USC 112, second paragraph. *See MPEP Section 2173.05(i).* Indeed, MPEP further indicates that a claim which recites a negative limitation to exclude the characteristics of the prior art product can be considered definite. *See MPEP 2173.05(i).*

Thus, even if the recited feature can be considered to be a negative limitation, a mere presence of the negative limitation is not enough to ignore the feature itself. Thus, the Examiner should have considered the entirety of the claims including the alleged negative feature.

When this recited feature is taken into account, it is clear that the claims are distinguishable over Hirabayashi. Indeed, even the Examiner admitted as

much. In the Office Action dated May 12, 2004, the Examiner stated "it is true that Hirabayashi discloses enlarging the original image." *See May 12, 2004 Office Action, page 2, lines 11-12.* Thus, even by the Examiner's own admission, the independent claims are distinguishable over Hirabayashi for at least the reasons related to this feature.

The Examiner indicates that the step of the enlarging and input image as disclosed in Hirabayashi is not relied upon. *See Final Office Action, page 2, lines 16-17.* However, as demonstrated above, this is clearly improper. As long as the feature is recited in the claims, to properly reject a claim under 35 USC 102, the feature must be present in the reference. As indicated above and as admitted by the Examiner, the recited feature clearly cannot be found in Hirabayashi.

The Examiner also states that the enlarged image in Hirabayashi is treated as the original image as claimed. However, the enlarged image in Hirabayashi clearly underwent previous enlargement which is contrary to the claimed feature.

For at least the reasons stated above, independent claims 1, 14 and 18 are distinguishable over Hirabayashi. Claims 3 and 16 depend from independent claims 1 and 14, respectively. Therefore, for at least the reasons stated above with respect to independent claims 1 and 14, claims 3 and 16 are also distinguishable over Hirabayashi.

Applicant respectfully requests that the rejection of claims 1, 3, 14, 16, and 18 based on Hirabayashi be withdrawn.

**CONCLUSION**

All objections and rejections raised in the Final Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance. Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact Hyung Sohn (Reg. No. 44,346), to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH &, BIRCH, LLP

By: 

D. Richard Anderson  
Reg. No. 40,439

<sup>HNS</sup>  
DRA/HNS/jm/slb  
1982-0136P

P.O. Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000